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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,664	12/20/2001	Stuart J. Solomon	12587-022001 / 01316-00/U	1128
26212	7590	05/03/2005	EXAMINER	
FISH & RICHARDSON P.C. 225 FRANKLIN STREET BOSTON, MA 02110			BORISSOV, IGOR N	
			ART UNIT	PAPER NUMBER

3639

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/027,664	<b>Applicant(s)</b> SOLOMON ET AL.	
	<b>Examiner</b> Igor Borissov	<b>Art Unit</b> 3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8-11,13-16,18-21,23-26 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-11,13-16,18-21,23-26 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 1/28/2005 has been entered.

### ***Response to Amendment***

Amendment received on 1/28/2005 is acknowledged and entered. Claims 2, 7, 12, 17, 22, 27 and 29-34 have been canceled. Claims 1, 3, 6, 8, 11, 13, 16, 18, 21, 23, 26 and 28 have been amended. Claims 1, 3-6, 8-11, 13-16, 18-21, 23-26 and 28 are currently pending in the application.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1, 3-5, 16 and 18-20 are rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter. The claimed invention is not within the technological arts.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process,

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machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

*The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is*

*presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. In re Toma at 857.*

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

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Contrary to the claims in the above-cited cases, in the present application, the claims are completely silent with regard to technology and is purely an abstract idea or process steps that are employed completely without the use of any technology whatsoever. The method step of: "*enabling a first market participant to configure one or more business rules*" could be understood as making a decision how to conduct business. The method step of: "*accessing a system that is configured to ...*" could be understood as simply getting permission to use the system. The method step of: "*receiving electronic data from the first market participant*" could be understood as merely receiving a diskette with a file stored on the diskette. However, the claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001)). Although *Bowman* is not precedential, it has been cited for its analysis.

Furthermore, in accordance with MPEP 2106 (IV)(B)(2)(b) "Statutory Process Claims", not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts. See *Diamond v. Diehr*, 450 U.S. at 183-184, 209 USPQ at 6 (quoting *Cochrane v. Deener*, 94 U.S. 780, 787-788 (1877)).

The Claims in the present application do not appear to satisfy either of the two conditions listed above. First, the claims do not include limitations that would suggest a computer is being used to transform the data from one form to another that would place the invention in the technological arts. Second, disregarding the fact that there is no computer claimed that would physically transform the data, there does not appear to be any physical transformation of data. Thus, there neither appears to be any physical transformation of data from one form to another, which is based upon an algorithm or a calculation by a computer or processor, nor is there any technology claimed that would be used to transform the data.

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Because the independently claimed invention is directed to an abstract idea which does not recite a limitation in the technological arts, those claims are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 21 and 23-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (US 2002/0169664).**

**Claim 21.** Walker teaches a system for providing offers using a billing statement, comprising a memory and a processor which is capable of accessing an e-commerce system [0192]. Language as to: “wherein the processor is configured to access a system that is adapted to...” is given no patentable weight. MPEP 2106 (II) (C) states: *“Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.”* Furthermore, Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 528-531 (CCPA 1959). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus

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teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (bd Pat. App. & Inter. 1987).

Thus the structural limitations of Claim 21 are disclosed in Walker as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

**Claim 23.** Same system as in Claim 21. Language as to: “*wherein the configurable business rule is configured based on...*” is given no patentable weight. MPEP 2106 (II) (C) states: “*Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.*” Furthermore, Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 528-531 (CCPA 1959). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (bd Pat. App. & Inter. 1987).

Thus the structural limitations of Claim 21 are disclosed in Walker as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

**Claim 24.** Walker teaches processing business transactions representing different formats [0048].

**Claim 25.** Walker teaches rejecting a requested transaction if this transaction does not satisfy business rules [0093].

**Claim 26.** Walker teaches a computer-implemented method and system for providing offers using a billing statement, said computer-implemented method indicating a computer-readable medium containing program instructions for execution by a computer, which, when executed by the computer cause the computer to implement said method comprising view a business transaction from the system [0192].

Language as to: “a system that is configured to ...” is given no patentable weight. MPEP 2106 (II) (C) states: “Language that suggests or makes optional but does not



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require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.”

**Claim 28.** Same reasoning as applied to Claim 26.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Gharavy (US 2003/0004840).**

Walker et al. (Walker) teaches a method and system for providing offers using a billing statement, comprising:

**Claims 1, 6, 11 and 16.**

Providing business rules which are configured by a market participant (user) [0155];

receiving offer including a transaction-related information (portion) and specified amount which is to be charged during said transaction if said offer is accepted (expected related response portion) [0033];

converting said information from a first format to another format [0048];

receiving information related to an acceptance for the offer (expected related response) [0157];

matching information related to an acceptance (expected related response) with alternative offer related to the same transaction (transaction-related portion) [0157];

determining whether said received information satisfies at least one configurable business rule [0192], wherein the configurable business rule specifies a relationship

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between the received business transaction and the subsequent business transaction [0192]; [0155]; [0157];

establishing information related to subsequent business transaction based on said determination [0192]; [0155]; [0157].

Walker does not specifically teach *validating said information related to at least on business transaction; and enabling the market participant to track a status of said information related to the business transaction and the subsequent business transaction*. Also, Walker does not specifically teach that said another format is a *standard format*.

Gharavy teaches a method and system for performing collective validation of credential information, wherein:

credential data of a transaction is *validated* [0025]; [0105];

during said validation said data is *converted* in the format usable by the rule engine, for example *standard format* [0025]; [0105];

*tracking* information related to said credential data [0030].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Walker to include validating said information related to at least on business transaction; and tracking information related to said credential data, as disclosed in Gharavy, because it would advantageously enhance accuracy of the system, and make it more secure. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Walker to include that said data is converted in the standard format, as disclosed in Gharavy, because it would advantageously simplify the processing of said data.

**Claims 3, 8, 13 and 18.** Walker teaches said method and system, wherein the configurable business rule is configured based on at least one of a jurisdiction associated with the received business transaction, a time relationship between the received business transaction and a subsequent business transaction, and a business event associated with the received business transaction [0162].

**Claims 4, 9, 14 and 19.** Walker teaches processing business transactions representing different formats [0048].

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**Claims 5, 10, 15 and 20.** Walker teaches rejecting a requested transaction if this transaction does not satisfy business rules [0093].

***Response to Arguments***

Applicant's arguments filed 1/28/2005 have been fully considered but they are not persuasive.

In response to the applicant's argument that prior art does not disclose: electronic data representing the expected related response business transaction, is noted that Walker explicitly disclose this feature. Specifically, Walker teaches: receiving offer (electronic data) including a transaction-related information (portion) and specified amount which is to be charged during said transaction if said offer is accepted (expected related response portion) [0033].

***Conclusion***

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (571) 272-6801.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (571) 272-6812.

Any response to this action should be mailed to:

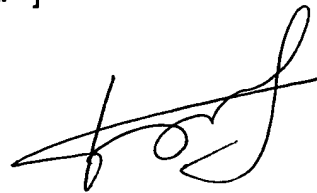
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**(703) 872-9306**

[Official communications; including After Final communications labeled "Box AF"]

Igor Borissov  
Patent Examiner  
Art Unit 3639



IB

4/30/2005